

### Office Action Summary

**Application No.**

10/712,715

**Applicant(s)**

SUYAMA ET AL.

**Examiner**

FRANK W. LU

**Art Unit**

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17, 19, 22, 23 and 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17, 19, 22, 23 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date 12/18/2007
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***CONTINUED EXAMINATION UNDER 37 CFR 1.114 AFTER FINAL REJECTION***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission of RCE and the amendment filed on December 21, 2007 have been entered. The claims pending in this application are claims 17, 19, 22, 23, and 25. Rejection and/or objection not reiterated from the previous office action are hereby withdrawn in view of applicant's amendment filed on December 21, 2007.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 17, 19, 22, 23, and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 17 is rejected as vague and indefinite in view of preamble because it is unclear whether the contents of (Fa, Sa) is used to further limit n kind of different nucleic acids or not. Please clarify.

5. Claim 17 is rejected as vague and indefinite in view of step (a). In first part of step (a), Aa is one of the probes groups A1 to An while, in the second part of step (a), the phrase "said probe Aa being respective first said probes Aa being respective first probes each of which has a

sequence F'a complementary to the respective first partial sequence Fa of the target nucleic acid (Fa, Sa) and a first binding molecule bound to the sequence F'a, wherein F'a is one of the sequences F'1 to F'n and wherein n is an integer of 2.0 or more" suggests that Aa is more than one different probes. Therefore, the first part of the second part of step (a) do not correspond each other. Furthermore, it is unclear whether the contents of (Fa, Sa) is used to further limit n kind of different nucleic acids. Please clarify.

6. Claim 17 is rejected as vague and indefinite in view of the phrase "a combination of the D0j and D1k (D0j, D1k) being assigned respectively to the target nucleic acids (Fa, Sa)" in step (a) because it is unclear whether the content of (D0j, D1k) is used to further limit D0j and D1k or not while whether the contents of (Fa, Sa) is used to further limit n kind of different nucleic acids or not. Please clarify.

7. Claim 17 is rejected as vague and indefinite in view of step (b) or (c) or (g) because it is unclear whether the contents of (Fa, Sa) is used to further limit n kind of different nucleic acids or not. Please clarify.

8. Claim 17 is rejected as vague and indefinite in view of steps (c) and (d) because it is unclear whether the contents of (Aa, Ba) is used to further limit the probes in steps (c) and (d) or not. Please clarify.

9. Claim 17 is rejected as vague and indefinite in view of steps (e) to (g) because it is unclear whether the contents of (D0j, D1k) is used to further limit the flag sequence in steps (e) to (g) or not. Please clarify.

10. Claim 19 or 25 is rejected as vague and indefinite because it is unclear whether the contents of (D0j, D1k) is used to further limit the flag sequence or not. Please clarify.

11. Claim 22 is rejected as vague and indefinite because it is unclear whether the contents of (Aa, Ba) is used to further limit the probes or not. Please clarify.
12. Claim 22 recites the limitation “the beads” in the claim. There is insufficient antecedent basis for this limitation in the claim because there is no word “beads” in claim 17. Please clarify.

***Conclusion***

13. No claim is allowed.
14. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is (571) 273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (571)272-0746. The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached on (571) 272-0735.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

/Frank W Lu /  
Primary Examiner, Art Unit 1634  
February 29, 2008

**Application Number****Application/Control No.**

10/712,715

**Examiner**

FRANK W. LU

**Applicant(s)/Patent under  
Reexamination**

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